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In re Application of :
Steinunn Baekkeskov et al. :
Serial No.: 08/838,486 : PETITION DECISION
Filed: April 07, 1997. :
Attorney Docket No.: 02307U-3122 :

This is in response to the petition under 37 CFR 1.181, filed July 10, 2006, requesting a review and reversal of the Examiner's decision refusing to enter new evidence submitted with the revised appeal brief filed August 13, 2004. The delay in responding to this petition is regretted, however, it has only just been brought to the attention of the deciding authority.

BACKGROUND

This application has a very long prosecution history beginning with a restriction requirement mailed on February 12, 1998, restricting claims 31 to 42.

In response to the restriction, applicants elected claims 31 to 37, without traverse on March 16, 1998.

On April 28, 1998, a non-final Office action was mailed rejecting claims 31 to 37 under 35 U.S.C. 112, first paragraph; rejecting claims 31 to 34 under 35 U.S.C. 112, second paragraph; rejecting claims 31 and 35 under 35 U.S.C. 102 and rejecting claims 31, 32, 33 and 35 to 37 under 35 U.S.C. 103.

On November 2, 1998, applicants responded by amending the claims and specification, adding new claims and arguing the rejections.

On January 22, 1999, the examiner mailed a second non-final Office action rejecting claims 31, 34, 35 and 49 to 53 under 35 U.S.C. first paragraph, rejecting claim 31 and 35 under 35 U.S.C. 102 and rejecting claims 35 and 54 to 57 under 35 U.S.C. 103.

On July 28, 1999, applicants responded by amending the claims and arguing the rejections.

On October 12, 1999, the examiner mailed a final Office action rejecting claims 31, 34, 35, 49-53 and newly added claim 58 and 59 under 35 U.S.C. first paragraph, rejecting claim 31 under 35 U.S.C. 102 and rejecting claims 35 and 54 to 57 under 35 U.S.C. 103.

In response thereto, applicants filed a CPA on April 14, 2000.

On July 5, 2000, the examiner mailed a non-final Office action rejecting the.

On January 10, 2001, applicants amending the claims and argued the rejections.

On April 24, 2001, the examiner mailed a final Office action rejecting claims 31, 34, 49-59, 60 and 61 under 35 U.S.C. first paragraph, rejecting claim 31 under 35 U.S.C. 102 and rejecting claims 35, 54-57 and new claims 62 and 63 under 35 U.S.C. 103.

On October 9, 2001, applicants responded with an amendment after final.

On November 7, 2001, the examiner mailed an advisory action stating the amendment after final would be entered.

On June 4, 2002, applicants filed a request for a CPA.

On August 5, 2002, a notice of non-compliant amendment was mailed to applicants.

Applicants responded on August 14, 2002 with the proper amendment.

On November 4, 2002, a non-final Office action was mailed wherein the CPA was acknowledged, the election of group I, without traverse was acknowledged, the rejection of claims 31, 34, 49-53, 58-59 and 62-63 under 35 U.S.C. 112 first paragraph scope of enablement was maintained; and the rejection of claim 31 under 35 U.S.C. 102(e) over US 5,762,937 was maintained. Claims 62 and 63 were rejected under 35 U.S.C. 112 second paragraph. Claims 35 and 54-57 were rejected under 35 U.S.C. 102 (b) over US 4,086,142. Claims 35, 49 and 54-57 were rejected under 35 U.S.C. 102(e) over US 5,762,947. Claims 34, 50-53 and 58-59 were rejected under 35 U.S.C. 103(a) over US 5,762,947.

The examiner and the applicants had an interview on March 27, 2003 to clarify that the Office action mailed on November 04, 2002 was a non-final action.

The applicants filed declarations along with arguments and an amendment on May 08, 2003 and new claims 64-67 were added.

Applicants submitted another declaration on May 23, 2003.

The examiner mailed a final Office action on July 29, 2003 wherein the examiner:

Withdrew the rejection of claims 62 and 63 under 35 U.S.C. 112 second paragraph.

Maintained the rejection of claims 31, 49-53, 58, 62-63 and also newly added claims 64-67 under 35 U.S.C. 112 first paragraph. Addressed and argued the applicants arguments presented in the declaration.

Maintained the rejection of claim 31, 35, 49, 54-57 and newly added 64 and 65 under 35 U.S.C. 102(e) over US 5,762,937.

Maintained the rejection of claims 50-53, 58-59 and on the newly added claims 66 and 67 under 35 U.S.C. 103 over US 5,762,937.

Rejected claims 35, 54-57 under 35 U.S.C. 103 over US 4,086,142 in view of US 4,736,020. 9 necessitated by the amendment.

In response, applicants filed a notice of Appeal on January 16, 2004.

Applicants filed an Appeal Brief with a 2nd declaration from Steinun Baekkeskov on May 03, 2004 and an after final amendment canceling claims 49 and 58.

The examiner entered the after final amendment on July 12, 2004 which canceled the claims 49 and 58, but sent a non-compliance letter with a shortened statutory period as applicants cited numerous references, evidence and also a new declaration on July 13, 2004.

On August 16, 2004 applicants filed a revised appeal brief in which he argued the reasons for presenting the evidence.

On October 27, 2004, the examiner again sent a non-compliance letter with a shortened statutory period, indicating that the appeal brief was defective as it contained new evidence.

On November 15, 2004, applicants sent in arguments as to why their appeal brief and declaration were proper and also submitted 61 pages of remarks, arguments and references on December 13, 2004.

The examiner mailed an advisory action on April 21, 2005 stating the affidavit or other evidence would not be entered as it was not timely filed before the appeal brief. The examiner also indicated the rejections of record were maintained.

Applicants filed several status letters on July 11, 2005, September 29, 2005 and March 03, 2006.

The examiner responded on June 1, 2006, with another non-compliance letter and repeated that the appeal brief contained a declaration and new evidence and hence was not in compliance with 37 CFR 41.37.

In response thereto, applicants filed this petition on July 10, 2006, requesting a review and reversal of the Examiner's decision refusing to enter new evidence submitted with the appeal brief filed August 16, 2004. Applicants also submitted a second appeal brief without the evidence on July 10, 2006.

A Patent Appeals Specialist mailed a non-compliance letter, on July 28, 2006, indicating that the brief was not in compliance as it failed to map each independent claim by page and line number of the specification.

In response thereto, applicants filed another brief on August 14, 2006.

DISCUSSION

Applicants argue that In the Notification of Non-Compliance, the Examiner states that the reason for refusing to enter the declaration and exhibits is that no new rejections nor grounds for rejection were made by the Examiner. However, applicants argue these comments apply the wrong standard for entry of the declaration or exhibit after appeal. The standard for entry of a declaration or exhibits with an appeal brief is provided by 37 CFR 1.195, which states:

Affidavits, declarations, or exhibits submitted after the case has been appealed will not be admitted without a showing of good and sufficient reason why they were not presented earlier.

Applicants further argue the exhibits and declaration address new points of argument raised by the Examiner in the final office action and that the exhibits and declarations could not have been presented earlier because the arguments they address were not presented before the final office action by the Examiner. The Baekkeskov declaration and its exhibits and the Findlay reference are considered by applicants to specifically address new points of argument raised by the Examiner in the final Office action.

Applicants further argue that the examiner has consistently taken the position (Notification of Non-Compliance of July 13, 2004 and June 1, 2006) that he can refuse entry of the requested evidence because "no new rejections nor grounds for rejection were made by the Examiner." In applicants' submission, the Examiner's position does not apply the standard of 37 CFR 1.195 (or for that matter of 37 CFR 41.33). Regardless as to whether the Examiner's new arguments were responsive to new evidence by applicants or other reason, the fact remains that the arguments were new and could not have reasonably been addressed by applicants before the new arguments were made. Thus, under 37 CFR 1.195, which was in effect on August 13, 2004 when the evidence was offered, the evidence should have been admitted.

According to 37 CFR 41.33, an affidavit may be entered if the examiner determines that it overcomes all the rejections under appeal. Specifically, 37 CFR 41.33 states:

(d)

(1) An affidavit or other evidence filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) and prior to the date of filing a brief pursuant to § 41.37 may be admitted if the examiner determines that the affidavit or other evidence overcomes all rejections under appeal and that a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented has been made.

This does not appear to be the case here. The affidavit and the evidence submitted here are only to argue the 35 U.S.C. 112, first paragraph rejection. Even if it did overcome this particular rejection, there are still other rejections of the claims. Thus, all rejections would not be overcome. Therefore, it is at the examiner's discretion to not to enter the evidence at this stage of prosecution. The arguments put forth in the final Office action were in response to the declaration submitted on May 23, 2003, which was prior to the final Office action, thus, these arguments could not have been presented by the examiner before.

DECISION

The petition is **DENIED**.

This application will be forwarded to the examiner for consideration of the second appeal brief filed August 14, 2006, without the evidence.

Should there be any questions about this decision please contact Ms. Marianne Seidel, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number 571-273-8300.



George C. Elliott
Director, Technology Center 1600